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AUG 16 2004

**OFFICE OF PETITIONS**

In re Application of :  
Norman P. Lewis :  
Application No. 10/674,181 : DECISION REFUSING STATUS  
Filed: 29 September, 2003 : UNDER 37 CFR 1.47(b)  
Attorney Docket No. Performance :  
Stamping PLUS :  
:

This is in response to the petition filed on 19 July, 2004, under 37 CFR 1.47(b).

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**  
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 29 September, 2003, without an executed oath or declaration.

Accordingly, on 18 December, 2003, Initial Patent Examination Division mailed a Notice To File Missing Parts of Nonprovisional Application requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 19 July, 2004,<sup>1</sup> the present petition was filed, accompanied by the petition fee, late filing surcharge, and a

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<sup>1</sup>As 18 July, 2004, fell on Sunday, this petition was timely filed.

five (5) month extension of time.

Petitioner asserts that the inventor has refused to sign the declaration.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest, and
- (6) proof of irreparable damage.

The petition lacks items (1) and (5).

In regards to item (1), petitioners must supply proof that a copy of the application (specification including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor for review.<sup>2</sup> The affidavit of Kenneth R. Morency, President of Performance Stamping Company, Inc., does not appear to state that Mr. Morency has first-hand knowledge that a copy of the application papers (specification, claims, drawings, if any, and the declaration) was presented to the non-signing inventor. Petitioners should submit a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign can be alleged, petitioners must show that the application papers were sent or given to the non-signing inventor. If the inventor refuses to sign the declaration in writing after being sent or given the application, a copy of that written refusal should be supplied with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (5), petitioner must show proof of proprietary interest. Petitioner may make this showing by providing a copy

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<sup>2</sup>MPEP 409.03(d).

of any employment agreement between the non-signing inventor and the Rule 1.47(b) applicant (employer); a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 1.47(b) applicant; or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would, by the weight of authority in that jurisdiction award the title of the invention to the Rule 1.47(b) applicant.

The legal memorandum provided by attorney Thomas L. Lockhart is not acceptable because Mr. Lockhart states that he is not registered to practice in Illinois, and does not state that he is familiar with the law of the jurisdiction (i.e., Illinois). Additionally, attorney Lockhart's memorandum does not state that a court of competent jurisdiction would, by the weight of authority in that jurisdiction award the title of the invention to the Rule 1.47(b) applicant.

Further correspondence with respect to this matter should be addressed as follows:

By mail:            Mail Stop Petition  
                          Commissioner for Patents  
                          P.O. Box 1450  
                          Alexandria, VA 22313-1450

By FAX:            (703) 872-9306  
                          Attn: Office of Petitions

By hand:            U.S. Patent and Trademark Office  
                          220 20<sup>th</sup> Street S.  
                          Customer Window, Mail Stop Petition  
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                          Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-6918.



Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions